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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,683	08/31/2005	Philippe Espiard	264120US0PCT	9269
22850 7590 06/24/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER THOMPSON, CAMIE S				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
06/24/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdoCKET@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/519,683

Applicant(s)

ESPIARD ET AL.

Examiner

Camie S. Thompson

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed 3/9/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) 16-22,25,26 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15, 23-24 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment and accompanying remarks filed March 9, 2009 are acknowledged.
2. Examiner acknowledges amended claims 14, 15, 24 and 27.
3. Examiner acknowledges cancelled claims 1-12.
4. Examiner acknowledges withdrawn claims 16-22, 25-26 and 28. Claims 13-28 are pending.
5. The rejection of claims 14-15, 24 and 27 under 35 U.S.C. 112, second paragraph is overcome by applicant's amendment.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13-15, 23-24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Marchetti et al., U.S. Patent Number 4,501,787.

Marchetti discloses a woven fibrous glass cloth impregnated with an epoxy resin as per instant claims 15, 24 and 27 (see column 2, lines 38-44). Additionally, the reference discloses that the epoxy resin has an EEW of about 482 (see Example 2). It is disclosed in Example 1 that

the woven glass fiber cloth has a weight of 6.0 oz/sq. yd (23 g/m²). Example 2 discloses that the epoxy resin is present in the amount of 77.93% as required by the present claims. The reference does not disclose the density of the product. However, the reference does have the same components and required by the present claims. Therefore, it would be expected that the product of the Marchetti reference have a density between 4 and 2000 kg/m³ as required by present claim 23.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 13-15, 23-24 and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 13-15, and 17-18 of copending Application No. 10/578571. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in both the present and co-pending applications recite an insulation product comprising mineral fibers wherein the fibers have a grammage from 10 to 300 g/m² and at least one of the external faces of the product have a binder present in the amount of 1% by weight.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

10. Applicant's arguments filed March 9, 2009 have been fully considered but they are not persuasive. The examiner corrected the oversight of not including claim 13 in the rejections in the previous office action. Applicant argues that the Marchetti reference discloses a prepreg used for laminates. Applicant argues that structure of the Marchetti product would not function as a

thermal or acoustic insulation product. The present claims recite a product based on mineral fibers wherein the fibers are glass fibers having a grammage of $10\text{-}300\text{ g/m}^2$, an organic cured resin present in the amount of at least 1% wherein the resin comprises at least one epoxy resin having an EEW value of 150-2000. Marchetti discloses a product having a woven fibrous glass cloth having a grammage of 23 g/m^2 impregnated with an epoxy resin having an EEW value of 482. The product of the Marchetti reference has the same components as the product of the present claims. The use of the product is not given any patentable weight. The Marchetti rejection is maintained.

Applicant argues that the claims of the co-pending application 10/578,571 do not render the present invention obvious. Claims 13-15 of the co-pending application recite a thermal and/or acoustic insulation product comprising mineral wool, especially glass, with a sizing composition comprising an epoxy resin having an EEW value between 150 and 2000. The present claims recite a thermal and/or acoustic insulation product based on mineral fibers (glass) with a resin from a sizing composition comprising an epoxy resin having an EEW value between 150 and 2000. The claims in both co-pending applications contain open language and have the same components for an insulation product.

Applicant argues that the present application is based upon a PCT application of July 9, 2003 and was filed in the US August 31, 2005 prior to the U.S. filing date of the co-pending application. Both applications are pending. The present application is not in condition for allowance. The double patenting rejection is maintained.

This is a non-final office action due to claim 13 being inadvertently omitted from the previous office action. Examiner regrets the inadvertent omission of claim 13 in the previous office action dated 12/08/08.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camie S. Thompson whose telephone number is 571-272-1530. The examiner can normally be reached on Monday-Friday 8:00 am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, D. Lawrence Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/
Supervisory Patent Examiner, Art Unit 1794

Camie S Thompson
Examiner
Art Unit 1794

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